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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/562,150

12/23/2005

Yoshihiro Kobayashi

2005-2039A

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03/03/2009

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EXAMINER

VARNUM, RYAN A

ART UNIT

PAPER NUMBER

4118

MAIL DATE

DELIVERY MODE

03/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/562,150	Applicant(s) KOBAYASHI ET AL.	
	Examiner RYAN VARNUM	Art Unit 4118	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/23/2005; 10/21/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is responsive to the amendment filed on 12/23/2005. As directed by the amendment: claims 4-5, and 7-10 have been amended, and claims 11-20 have been added. Thus, claims 1-20 are presently pending in this application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 7, 9-10, and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Baudino (WO 01/32439).

4. In re Claim 1, Baudino discloses a barrel for a writing implement, comprising: a barrel body having a gripping part 1 ("implement body"; Fig. 2, Page 5, Line 16-17); and a grip member 10 of layered structure (Page 6, Lines 1-3) formed by assembling an inner member 2 (Fig. 2) of a soft material ("low durometer TPE layer"; Page 5, Lines 29-30) and an outer member 3 (Fig. 2), and put on the gripping part of the barrel body (Fig. 2); wherein the inner member is covered with the outer member (Fig. 2), and the outside surface of the inner member and the inside surface of the outer member are formed in

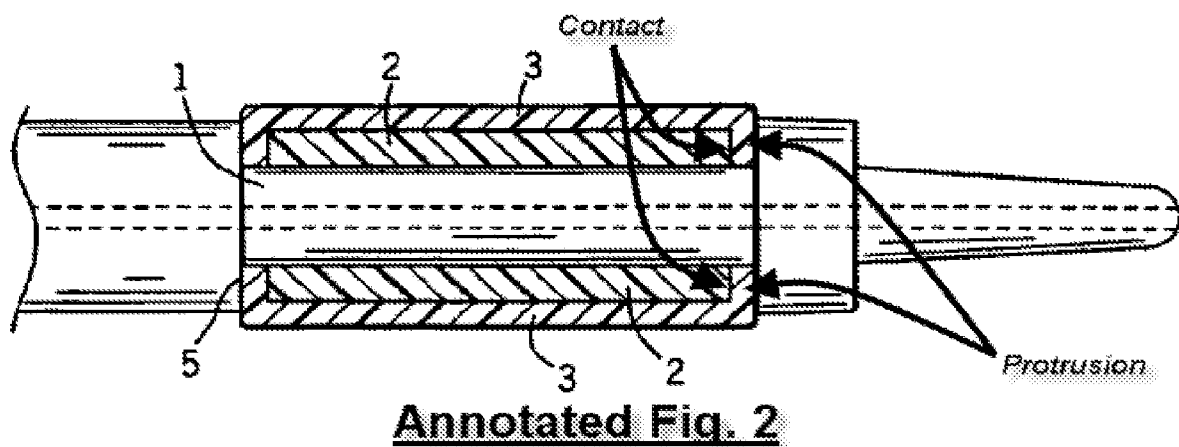
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an assembly facilitating shape ("triangular cross-section") for facilitating putting the outer member on the inner member (Page 6, Lines 4-8).

5. In re Claims 2 and 3, Baudino further discloses the assembly facilitating shape being a protruding and depressed shape ("triangular cross-section"; Page 6, Lines 4-8); and the assembly facilitating shape is a tapered shape ("triangular cross-section").

6. In re Claims 7, and 16-17, Baudino further discloses the inner member 2 (Fig. 2) and the outer member 3 (Fig. 2) are made of materials of different hardnesses, respectively, the inner member is made of a soft material having a low hardness ("low durometer TPE layer"; Page 5, Lines 29-30), and the outer member is made of a soft material having a high hardness ("higher durometer layer"; Page 5, Line 29).

7. In re Claim 9, Baudino further discloses the outer member 3 (Fig. 2) is be provided with a radially inwardly extending protrusion ("protrusion"; See Annotated Fig. 2 below) at the front end thereof and the back end surface of the protrusion is in contact with the front end surface of the inner member 2 ("contact"; See Annotated Fig. 2 below).



8. In re Claim 10, Baudino further discloses a part of the outer member 3 (Fig. 2) corresponding to the inner member 2 (Fig. 2) has a mean wall thickness between 1 and 5 mm ("1 to 10 mils"; Page 2, Line 1).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4-5, 11-15, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baudino in view of Siegel (US Patent 3,250,033).

11. In re Claims 4, and 11-12, Baudino discloses all the claimed features, except for the outer member being put on the inner member so as to be separable from the inner member and the barrel body. However, Siegel teaches a writing implement having a barrel body 11 (Fig. 2) including a gripping portion comprising an outer member 23 (Fig. 1) and inner member 20 (Fig. 1) wherein the outer member is put on the inner member so as to be separable from the inner member and the barrel body (Column 2, Lines 27-29), for the purpose of facilitating removal and replacement of the separate members (Column 2, Line 29).

Therefore, it would have been obvious to a person having ordinary skill in the art, at the time the invention was made, to modify the device of Baudino, such that the outer member is put on the inner member so as to be separable from the inner member and the barrel body, as taught by Siegel, for the purpose of facilitating removal and replacement of the separate members.

12. In re Claims 5, and 13-15, Siegel further discloses the outer member 23 (Fig. 1) is transparent or semitransparent (Column 2, Lines 13-14) and the inner member 20 (Fig. 1) is colored in a color different from that of the outer member ("opaque...and carry indicia"; Column 2, Lines 1-2).

13. In re Claims 18-19, Baudino further discloses the inner member 2 (Fig. 2) and the outer member 3 (Fig. 2) are made of materials of different hardnesses, respectively, the inner member is made of a soft material having a low hardness ("low durometer TPE layer"; Page 5, Lines 29-30), and the outer member is made of a soft material having a high hardness ("higher durometer layer"; Page 5, Line 29).

14. Claims 6 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baudino in view of Siegel, further in view of Asanuma (US Patent 5,888,636).

15. In re Claim 6, the combination of Baudino/Siegel discloses all the claimed features, except for the inside surface of the outer member is glossy. However, Asanuma teaches the application of a glossy surface to a multi-layer transparent plastic article for the purpose of creating the impression of a high-grade product, and increased transparency characteristics (Column 1, Lines 17-19 and 42-46).

Therefore, it would have been obvious to a person having ordinary skill in the art, at the time the invention was made, to modify the device of Baudino/Siegel, such that the inside surface of the outer member is glossy, as taught by Asanuma, for the purpose of creating the impression of a high-grade product, and increased transparency characteristics.

16. In re Claim 20, Baudino further discloses the inner member 2 (Fig. 2) and the outer member 3 (Fig. 2) are made of materials of different hardnesses, respectively, the inner member is made of a soft material having a low hardness ("low durometer TPE layer"; Page 5, Lines 29-30), and the outer member is made of a soft material having a high hardness ("higher durometer layer"; Page 5, Line 29).

17. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baudino in view of Kazunori (JP Patent 11-216985).

18. In re Claim 8, Baudino further discloses the inside diameter of the outer member 3 (Fig. 2) is greater than the outside diameter of the inner member 2 (Fig. 2). Baudino does not disclose the outer member being axially compressed when put on the grip part of the barrel body. However, Kazunori teaches a dual-layer grip member 10/11 (Fig.'s 1-4), where the outer member 11 is axially compressed ("press-fitted"; Abstract) when put on the grip part of the barrel body, for the purpose of providing a grip member with a favorable external appearance (Abstract).

Therefore, it would have been obvious to a person having ordinary skill in the art, at the time the invention was made, to modify the device of Baudino, such that the outer

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member is axially compressed when put on the grip part of the barrel body, as taught by Kazunori, for the purpose of providing a grip member with a favorable external appearance.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN VARNUM whose telephone number is (571) 270-7853. The examiner can normally be reached on Monday - Friday, 9:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Quang Thanh can be reached on (571) 272-4982. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. V./
Examiner, Art Unit 4118

/Quang D. Thanh/
Supervisory Patent Examiner, Art
Unit 4118